Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte EDWARD R. HARRISON and JASON DISHLIP

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Appeal No. 2004-0468
Application 09/754,555

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ON BRIEF

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Before BLANKENSHIP, SAADAT, and MACDONALD, **Administrative Patent Judges**.

MACDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-4, 6-10, and 12-15. Claims 5 and 11 have been canceled.

Invention

Appellants' invention relates to a method, system, and article for translating interaction with a touch screen into a mouse event. When a user's finger or stylus is removed from the

touch screen, a mouse click event is generated. Appellants' specification at page 3, lines 15-16, and page 4, lines 15-21.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A method comprising:

receiving touch information from a touch screen;

converting said touch information into mouse commands; and

detecting the cessation of contact with the touch screen and generating a mouse click event in response to the detection of the cessation of contact.

References

The references relied on by the Examiner are as follows:

Tannenbaum et al. (Tannenbaum)	5,252,951	Oct. 12, 1993
Mikan	5,428,367	Jun. 27, 1995

Rejections At Issue

Claims 1-4, 6-10, and 12-15 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Mikan and Tannenbaum.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.[1]

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated **infra**, we affirm the Examiner's rejection of claims 1-4, 6-10, and 12-15 under 35 U.S.C. § 103.

Appellants have indicated that for purposes of this appeal the claims stand or fall together in a single grouping. See page 5 of the brief. Appellants have fully met the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellants' filing of the brief. 37 CFR § 1.192 (c)(7) states:

> *Grouping of claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the

[1]Appellants filed an appeal brief on June 4, 2003. Appellants filed a reply brief on July 28, 2003. The Examiner mailed out an Examiner's Answer on July 11, 2003.

> ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellants' claims as standing or falling together in one group, and we will treat claim 1 as a representative claim of the group.

I. Whether the Rejection of Claims 1-4, 6-10, and 12-15 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-4, 6-10, and 12-15. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can

satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, Appellants argue at page 5 of the brief, "the method in claim 1 as a whole is not taught or suggested because the detection of the cessation of

contact with a touch screen cannot map always to a single mouse equivalent command that generates a mouse click event." The Examiner rebuts this at page 7 of the answer by pointing out that, "this statement was not claimed." We have reviewed the language of claim 1 and we agree with the Examiner. There is nothing in claim 1 that requires the cessation "always map to a single mouse equivalent command." Although, we do find that in each mode of Tannenbaum, the cessation does map to a single mouse equivalent command. See Tannenbaum at column 13, lines 14-20.

Appellants also argue, "Tannenbaum merely shows a mouse double click generated upon lift-off, the mouse double click is determined by the selected mode rather than solely in response to the detection of the cessation of contact, as claimed in claim 1." We have reviewed the language of claim 1 and again we agree with the Examiner. There is nothing in claim 1 that requires the determination is "solely in response to the detection of the cessation of contact." Further, we point out that we find all the limitations of claim 1 are present in Tannenbaum. In addition to the "detecting and generating" pointed out by the Examiner, Tannenbaum teaches the "receiving and converting" steps of claim 1 at column 12, lines 67, through column 13, line 6.

Appellants argue at page 6 of the brief, "Mikan merely teaches that when user finger position on the touch screen stops, cursor position stops without generating a mouse-click event." We have fully reviewed the Mikan reference and we do not agree with the Appellants' argument. Mikan also teaches that a mouse click closure is generated when touching of a zone on the touch screen is detected. See Mikan at column 18, lines 14-23. We find that this section of Mikan teaches the desirability of "duplicating mouse switch functions" (line 15) and provides more than sufficient motivation to also duplicate the mouse switch function of "mouse button up" upon the detection of cessation of contact as taught by Tannenbaum at lines 18-20 of column 13.

At page 2 of the reply brief, Appellants argue "the conclusion that modifying the Mikan method using the Tannenbaum approach set forth above in that upon detecting the cessation of contact with a touch screen (lifting the user's finger from the touch screen or liftoff) must generate a mouse click event, let alone a particular mouse click event only, is incorrectly drawn." We reiterate that, as discussed above, there is nothing in claim 1 that requires the cessation "always map to a single mouse equivalent command." Also, we find that the plain language of

Tannenbaum at column 13, lines 14-20, teaches detecting a cessation of contact with a touch screen must generate a mouse click event. Appellants' argue at page 3 of the reply brief that "the possibility still exists, however, that the detection of cessation of contact with a touch screen may not map to such a mouse-equivalent command". Appellants have provided no basis in Tannenbaum or elsewhere for this contention. Without some indication by the Appellants of their basis for this argument, the argument is mere speculation given the plain meaning of column 13 of Tannenbaum and as such this argument is unpersuasive.

We find that the Examiner has met the initial burden of establishing a **prima facie** case of obviousness. We further find that the Appellants have not presented a sufficient showing to overcome this **prima facie** case. Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 103 of claims 1-4, 6-10, and 12-15.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

HOWARD B. BLANKENSHIP Administrative Patent Judge	)	
MAHSHID SAADAT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ALLEN R. MACDONALD Administrative Patent Judge	)	

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